

REMARKS

This response is being filed in response to the non-final Office Action dated September 18, 2008. Dependent claims 21-25 are newly presented. No new matter is added. Claims 3, 4, 7-14, 18 and 20-25 are active for examination. For reasons discussed below, it is believed that this case is in condition for allowance. Prompt favorable reconsideration of this application is requested.

Claim 3, representative of pending claims, describes a communication terminal, such as a cellular phone, that in the event of an incoming communication arrives from a communication partner in the course of a video reproduction carried out by the terminal, informs the communication partner of an end time of the video reproduction. The documents cited in the Office Action, even if combined, do not render the claimed features obvious.

Specific issues raised in the Office Action are addressed below.

The obviousness rejections of claims 3, 7, 9, 10, 11, 12, 18 and 20 are overcome

The Office Action rejected to claims 3, 7, 9, 11, 18 and 20 under 35 C.F.R. § 103(a) as being unpatentable over Tidwell et al. (U.S. Patent 6,535,590) in view of Chatterjee et al (U.S. Publication 2007/0248221) and Kusaba et al. (U.S. Patent 6,510,556). Claims 10 and 12 stood rejected under 35 C.F.R. § 103(a) as being unpatentable over Tidwell et al. in view of Chatterjee et al and Kusaba et al., and further in view of Buettgenbach et al. (Publication No. 2002/0032613). However, Tidwell, Chatterjee and Kusaba cannot support a prima facie case under 35 USC 103 because the combined documents cannot meet all the claim limitations by using known technique to improve similar devices in the same way, the combination of prior art elements according to known methods to yield predictable results, or the application of a known technique to a known device ready for improvement to yield predictable result.

Tidwell only describes a set top box that offers functions allowing a user to use telephone functions or managing call functions, such as forwarding calls, rejecting calls, etc., via a television, such as by entering the symbol *60 to the set top box. Chatterjee describes a device providing a function to delay a call, in which a caller calling the device is verbally notified by a facilitator device that the user is busy and that the user will call back at a later time. This future time may be specified by the facilitator. As correctly acknowledged by the Examiner, neither Tidwell nor Chatterjee discloses that an end time of a video reproduction process should be conveyed to a caller in the event that the caller calls the device when the video reproduction is being carried out by the device. In order to alleviate the deficiencies of Tidwell and Chatterjee, the Office Action intended to rely on a newly cited document, Kusaba.

However, Kusaba, standing alone, only describes a system for recording reservations for different TV programs broadcasted at different time. During a reservation process, the system obtains information related to a start and end time for each program. As the Background section of Kusaba clearly states, “[t]he invention relates to a video distributing apparatus for accepting a request of a viewer and automatically forming a distribution schedule of a video image” (see col. 1, lines 6-8 of Kusaba).

None of Kusaba, Tidwell and Chatterjee specifically teaches or suggests that an end time of a video reproduction should be conveyed to a caller in the event that the caller calls the device when the video reproduction is being carried out by the device. While Chatterjee describes notifying a caller that the user will call back at “a later time,” the only guidance that Chatterjee provides about selecting “the later time” is “based on the [caller and user’s] calendars” (see paragraph [0078] of Chatterjee). Without teachings from Applicant’s own disclosure indicating that an end time of a program should be conveyed to a caller, the only predictable

result that one of ordinary skilled in the art would have come up with from the combination of Tidwell, Chatterjee and Kusaba is a set-top box that includes telephone functions through a television (according to Tidwell), a delay call function that provides a verbal prompt to any caller that the user will call back at a later time determined by the caller and user's shared schedules (according to Chatterjee) and a function to reserve recording time for various TV programs (according to Kusaba). This combination, apparently, fails to teach or suggest that "in the event of an incoming communication from a communication partner in the course of the video reproduction carried out by said video reproduction device, said communication partner is informed of the end time of said video reproduction," as described in claim 3.

Since Tidwell, Chatterjee and Kusaba cannot support a prima facie case of obviousness, the obviousness rejection of claim 3 is overcome.

Independent claims 7, 18 and 20 include descriptions substantially similar to those of claim 3. Accordingly, claims 7, 18 and 20 are patentable for at least the same reasons as for claim 3.

Claims 9 and 11 depend on claims 3 and 7, respectively. Therefore, claims 9 and 11 are patentable by virtue of their dependencies.

Claims 10 and 12 depend on claims 3 and 7, respectively, and are rejected under 35 U.S.C. 103(a) as being unpatentable over Tidwell in view of Chatterjee, Kusaba and further in view of Buettgenbach.

Buettgenbach is cited for its purported discussion related to automatic generation of email notification. The teaching does not alleviate the deficiencies of Tidwell, Chatterjee and Kusaba, as discussed earlier relative to claim 3. Therefore, claims 10 and 12 are patentable for at least the same reasons as for claim 3.

The obviousness rejection of claims 4, 8, 13 and 14 is overcome

Claims 4, 8, 13 And 14 are rejected under 35 C.F.R. §103(a) as being unpatentable over Tidwell et al. in view of Chatterjee et al and Kusaba et al. and further in view of Willame et al. (Publication No. 2006/0179462). The obviousness rejection is overcome because the cited documents cannot support a prima facie case of obviousness.

Claim 4 describes a communication terminal that includes a setting device allowing a user to set an incoming-reporting condition indicating whether a video reproduction takes precedence of an operation to report an incoming communication or said operation to report an incoming communication takes precedence of said video reproduction. In the event of an incoming communication from a communication partner in the course of the video reproduction carried out by said video reproduction device: the communication partner is informed of the end time of said video reproduction if said incoming-reporting condition is set to indicate that said video reproduction takes precedence of an operation to report said incoming communication; and said incoming communication is reported if said incoming-reporting condition is set to indicate that an operation to report said incoming communication takes precedence of said video reproduction.

As discussed earlier relative to claim 3, the combination of Tidwell, Chatterjee and Kusaba cannot support a prima facie case of obviousness related to the feature of informing a communication partner of an end time of a video reproduction when an incoming communication arrives from the communication partner in the course of the video reproduction, as described in claim 4. Furthermore, Tidwell, Chatterjee and Kusaba, all fail to teach that the communication partner is informed of the end time of said video reproduction if said incoming-reporting condition is set to indicate that said video reproduction takes precedence of an

operation to report said incoming communication; and said incoming communication is reported if said incoming-reporting condition is set to indicate that an operation to report said incoming communication takes precedence of said video reproduction.

Another document, Willame, is cited by the Office Action for its purported discussion related to resolving time conflicts when recording two programs around the same time. One program is given higher priority than the other based on a priority list. Apparently, Willame's teaching is about resolving conflicting schedule of TV programs. It does not teach or suggest whether an incoming-reporting condition should be provided to indicate the relative preference of video reproductions and an incoming communication. Neither does Willame teach the specific actions taking place depending on how an incoming-reporting condition is set (the communication partner is informed of the end time of said video reproduction if said incoming-reporting condition is set to indicate that said video reproduction takes precedence of an operation to report said incoming communication; and said incoming communication is reported if said incoming-reporting condition is set to indicate that an operation to report said incoming communication takes precedence of said video reproduction).

Accordingly, the obviousness rejection of claim 4 based on Tidwell, Chatterjee, Kusaba and Willame is untenable and should be withdrawn. Favorable reconsideration of claim 4 is respectfully requested.

Claim 8 is patentable over Tidwell, Chatterjee, Kusaba and Willame for reasons similar to claim 4.

Claims 13 and 14 depend on claim 4. Therefore, claims 13 and 14 are patentable over the cited art by virtue of their dependencies as well as based on their own merits.

New claims 21-25 are patentable

New claims 21-25 depend on claims 3, 4, 7, 18 and 20, respectively, and further describe that the user is not informed of the incoming call from the communication partner either during the course of video reproduction or TV broadcasting, or when an incoming-reporting condition is set to indicate that video reproduction takes precedence of an operation to report incoming communications. This feature allows a user not to be disturbed by an incoming call when watching a television or a video reproduction.

None of the cited documents disclose or suggest such features. According to Tidwell, when a telephone call arrives, an audio tone is output or a visual indicator is displayed on a screen. See Figs. 4 and 5 of Tidwell. In this manner, Tidwell never teaches not to disturb a user from watching a TV program as described in this application. Tidwell specifically describes that “they merely have to select an icon” and “all that is necessary is that a particular icon be selected.” See column 7, lines 25 and 30. Accordingly, Tidwell relies on the assumption of requiring a user to select one of the icons even when the user is watching a TV program. Therefore, the teaching in Tidwell teaches away from meeting a device constructed according the claims which is designed to avoid interruptions to the user. This deficiency is not alleviated by any of the cited documents. Accordingly, claims 21-25 are patentable by virtue of their dependencies as well as based on their own merits.

CONCLUSION

For the reasons given above, Applicants believe that this application is in condition for allowance, and requests that the Examiner give the application favorable reconsideration and permit it to issue as a patent. If the Examiner believes that the application can be put in even

Serial No.: 10/807,469

better condition for allowance, the Examiner is invited to contact Applicants' representative listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

/Wei-Chen Nicholas Chen – Reg. No.: 56,665/

Wei-Chen Nicholas Chen

Registration No. 56,665

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 WC:pab
Facsimile: 202.756.8087
Date: January 21, 2009

**Please recognize our Customer No. 20277
as our correspondence address.**

WDC99 1674992-1.062758.0075